

Application No.: 10/763,687
94 C.F.R. § 1.53 (b): continuation
of Serial No. 09/359,809
Substitute Second Preliminary Amendment
Dated: November 29, 2005

Remarks

The preliminary amendment of January 24, 2004 amended page 21 of the written description to correct punctuation. Applicant has amended claims 60 and 66, now claims 90 and 95, to add cadmium oxide and lead monoxide to the category of solid lubricants. The application supports these amendments at page 16 penultimate paragraph and page 16 last paragraph respectively. Applicant has also amended the claims to address the examiner's withdrawal of the rejections in the parent application of claims 59-62, 94-68 and 71-72 over the prior art, and objection to them on the grounds they depended from a rejected claim. The January 24, 2004 amendment canceled claim 72 without prejudice or disclaimer, whereas the present amendment changes claims 59-62, 94-68 and 71(now claims 90-93, 94-97, and 98) so they no longer depend on a rejected claim. The amendment of January 24, 2004 canceled claims 57, 58, 63, 64, 69, and 70 without prejudice or disclaimer. Claims 57, 58, 63, 64, 69, and 70, however, remain in the parent application.

The amendment adds claims 99 and 100, dependent on claims 90 and 94 (formerly claims 59 and 65). The lubricant of claims 99 and 100 comprise the chalcogenides of non-noble metals and mixtures thereof, whereas claims 101 and 102 added by this amendment depend from claims 90 and 94 and further define the lubricant as comprising the chalcogenides of

Application No.: 10/763,687
94 C.F.R. § 1.53 (b): continuation
of Serial No. 09/359,809
Substitute Second Preliminary Amendment
Dated: November 29, 2005

molybdenum, antimony, niobium, and tungsten, and mixtures thereof. The application supports these claims at page 27, first and second paragraphs.

Claims 103 and 104 describe the chalcogenide of claims 99 and 100 as a sulfide, which page 27, first paragraph of the application supports. Claims 105-110 describe the mixture of lubricants of claims 90-104 as comprising a two, three, or four lubricant mixture, which page 27, second paragraph of the application supports.

Claim 111 relates to the combination of a grease lubricant with the superabsorbent polymer. The application supports claim 111 at page 13, last paragraph through page 15, first paragraph, and by claim 57 as well. Applicant, however, has now cancelled claim 57 without prejudice or disclaimer. None of the prior art relied on by the examiner in the parent application taught or suggested the superabsorbent polymer-grease combination now claimed.

The Provisional Double Patenting Rejection

Examiner Medley (now retired) provisionally rejected claims 57-72 in the parent application under the judicially created doctrine of obviousness-type double patenting in view of copending application Serial No. 09/357,957 filed July 23, 1999. Applicant points out that examiner Medley also issued a provisional double patenting rejection in copending application Serial No. 09/357,957, which has not issued as a patent. Applicant should not be required to

Application No.: 10/763,687
94 C.F.R. § 1.53 (b): continuation
of Serial No. 09/359,809
Substitute Second Preliminary Amendment
Dated: November 29, 2005

file a terminal disclaimer in the present application since the Patent Office may not allow the copending application which forms the basis of the double patenting rejection. Furthermore, the Manual of Patent Examining Procedure (M.P.E.P.) provides that when a provisional double patenting rejection is the sole remaining rejection in an application otherwise in condition for allowance, the examiner should withdraw the rejection in the application and permit it to issue as a patent. M.P.E.P. § 804(I)(B): p. 800 -15 July 1998.

Conclusions

Applicant requests the Examiner to consider the foregoing amendments and remarks and pass the application to issue.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: November 29, 2005

By: /Robert J. Eichelburg/ Reg. No. 23,057

Application No.: 10/763,687
94 C.F.R. § 1.53 (b): continuation
of Serial No. 09/359,809
Substitute Second Preliminary Amendment
Dated: November 29, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, Central FAX Number (571) 273-8300 on the date indicated below.

Dated: November 29, 2005

By: /Robert J. Eichelburg/ Reg. no. 23,057/